



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

<i>In re</i> the application of)	
Yasuhiko UCHIDA et al.)	Art Unit: 2625
Application No. 10/799,010)	Examiner: M. Riley
Filed: March 11, 2004)	Atty. Docket No. ITECP008
For: PRINT JOB CREATION APPARATUS,)	Date: September 2, 2008
JOB MANAGEMENT APPARATUS,)	Confirmation No. 7560
AND PRINT JOB MANAGEMENT)	
SYSTEM INCLUDING PRINT JOB)	
CREATION APPARATUS AND)	
<u>JOB MANAGEMENT APPARATUS</u>)	

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on September 2, 2008.

Signed: _____

Diane Schwanbeck

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants request review of the final rejections set forth in the Final Office Action dated April 30, 2008. This request is being filed concurrently with a Notice of Appeal.

Claims 1-12, 14, 15, and 17-21 are pending in the subject application. Claims 1 and 18 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Mizuki* (US 5,623,675) in view of *Suzuki et al.* ("*Suzuki*") (US 2004/0008363 A1) and *Terada et al.* ("*Terada*") (US 7,055,150 B2). Claims 2 and 21 have been rejected under 35 U.S.C. § 103(a) over the same combination of references applied against claim 1, and further in view of *Yokoyama* (US 7,126,719 B2). Claims 3 and 9 have been rejected under 35 U.S.C. §

103(a) over the same combination of references applied against claim 1, and further in view of *Suzuki*. Claims 4-8, 10, 11, 19, and 20 have been rejected under 35 U.S.C. § 103(a) over the same combination of references applied against claim 1, and further in view of *Suzuki*. Claim 12 has been rejected under 35 U.S.C. § 103(a) over the same combination of references applied against claim 1, and further in view of *Shiota et al.* (“*Shiota*”) (US 6,324,521 B1). Claims 14, 15, and 17 have been rejected under 35 U.S.C. § 103(a) over the same combination of references applied against claim 1, and further in view of *Terada*. As will be explained in more detail in the Argument section set forth below, the obviousness rejections are improper because the Examiner has failed to establish a *prima facie* case of obviousness against the claimed subject matter because the asserted combinations of references do not disclose or suggest each and every feature of the claimed subject matter.

ARGUMENT

Argument No. 1: Independent Claims 1 and 18

In formulating the obviousness rejection, the Examiner acknowledges that neither the *Mizuki* reference nor the *Suzuki* reference discloses or suggests a duplication process module as specified in present independent claims 1 and 18. To remedy this deficiency of the combination of the *Mizuki* and *Suzuki* references, the Examiner relies upon the *Terada* reference.

The *Terada* reference discloses a printer system for installing printer firmware to a printer through a network. As stated in the *Terada* reference, “[t]he printer according to the present invention functions printing data onto a printing medium, the media can be one of separate form, continuous form or duplication form.” Column 15, lines 11-13. Apparently the Examiner believes that the reference to “duplication form” somehow means that *Terada* discloses a duplication process module as specified in the claimed subject matter. The *Terada* reference, however, does not describe duplicating anything. Thus, the *Terada*

reference neither discloses nor suggests the functionality of the claimed duplication process module, namely duplicating a registered image corresponding to the specified print job under creation. As such, the *Terada* reference does not support the Examiner's obviousness rejection.

In column 11, lines 4-30, *Terada* discusses the interruption of a firmware installation while print processing is being carried out. Here, *Terada* teaches only the interruption and resumption of the firmware installation to a printer, whereas the claimed subject matter involves the interruption and resumption of the creation of a print job. As such, there is simply not enough pertinent description in the *Terada* reference to reasonably conclude that this reference discloses or suggests the duplicating of a registered image corresponding to the specified print job under creation, as specified in the claimed subject matter.

Thus, for at least the foregoing reason, even if the *Mizuki*, *Suzuki*, and *Terada* references were to be combined in the manner proposed by the Examiner (a proposition with which Applicants disagree because the requisite motivation to combine the references is lacking), the combination would not have resulted in a print job creation apparatus or a print job management system having each and every feature of the claimed subject matter. Accordingly, the combination of *Mizuki* in view of *Suzuki* and *Terada* does not raise a *prima facie* case of obviousness against independent claims 1 and 18.

Argument No. 2: Dependent Claims

Each of dependent claims 2-12, 14, 15, 17, and 19-21 ultimately depends from either claim 1 or claim 18. In formulating the obviousness rejections for these dependent claims, the Examiner has relied upon two additional references, namely *Yokoyama* and *Shiota*. Neither the *Yokoyama* reference nor the *Shiota* reference, however, cures the above-discussed deficiencies of the combination of the *Mizuki*, *Suzuki*, and *Terada* references relative to the subject matter defined in present independent claims 1 and 18. Accordingly, each of the

dependent claims is patentable under 35 U.S.C. § 103(a) over the same combination of references applied against claim 1, and further in view of one or more of the *Yokoyama*, *Shiota*, and *Terada* references for at least the reason that each of these claims ultimately depends from either claim 1 or claim 18.

Conclusion

For the reasons set forth above, the combination of *Mizuki* in view of *Suzuki* and *Terada* does not disclose or suggest each and every feature of the subject matter defined in independent claims 1 and 18. It is axiomatic that the prior art must disclose or suggest each and every feature of the claimed subject matter to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a). Accordingly, the combination of *Mizuki* in view of *Suzuki* and *Terada* does not raise a *prima facie* case of obviousness against the subject matter defined in the present independent claims.

In view of the foregoing, Applicants respectfully submit that claims 1-12, 14, 15, and 17-21 are in condition for allowance. Accordingly, a notice of allowance is respectfully requested. In the event a telephone conversation would expedite the prosecution of this application, Applicants' undersigned representative may be reached at (408) 749-6902. If any fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees to Deposit Account No. 50-0805 (Order No. ITECP008).

Respectfully submitted,
MARTINE PENILLA & GENCARELLA, LLP



Peter B. Martine
Registration No. 32,043

710 Lakeway Drive, Suite 200
Sunnyvale, California 94085
Customer No. 25920